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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,028	09/17/2003	Soo-hong Park	Q76745	2599
23373	7590	09/13/2007	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KEEFER, MICHAEL E	
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,028	PARK, SOO-HONG
	Examiner	Art Unit
	Michael E. Keefer	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>7/20/2007</u>	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. This Office Action is responsive to the Amendment filed 7/16/2007.

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-2 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2 of copending Application No. 10/746234. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 4-5 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-7 of copending Application No. 10/746234. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3 and 4-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 5-6 of copending Application No. 10/675953. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 5-6 of '953 disclose all the limitations of claims 1-3 and 4-5 of the instant application except where in the interface ID area the device ID is placed. The exact placement of the device ID in a specific area of the interface ID area is a matter of routine experimentation and design choice produces predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations added to claims 1 and 5 "outputting information regarding the identified devices" is not supported by the disclosure. In addition, the amendment to the specification is new matter by deletion.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 4**, the "computer readable recording medium," in accordance with Applicant's specification, may be carrier waves (pg. 20, [74], line 7). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

In addition, **claim 4** is directed solely to a data structure to hold information. This subject matter is not limited to that which falls within a statutory category of invention

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because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes functional descriptive material. Functional descriptive material does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

**Claim 5**, which is dependent from claim 4, fails to remedy any of the deficiencies of claim 4 and thus is rejected for the same.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinden et al. (RFC 2373, "IP Version 6 Addressing Architecture"), hereafter Hinden, and Marttinen et al. (US 6222853), hereafter Marttinen.

Regarding **claims 1-3 and 4-5**, Hinden discloses an interface ID having a company ID area and serial number area having an EUI-64 ID format according to an IPv6 address system and using the serial number to identify the device. See page 19, the first figure and page 21, first and second paragraphs which state that the

manufacturer id area (i.e. the area labeled 'm') may be used as an extension identifier (as taught on page 21, this identifier can be a serial number, making the 'm' bit area a serial number area).

Hinden discloses all the limitations of claims 1-3 except for a device ID area recorded in the interface ID in an area excluding the serial number and company ID area and that the device ID is between the company ID area and the serial number area.

The general concept of a device ID in an address area is well known in the art as taught by Marttinen. (Fig. 3a and 3b teach including a device ID type for identifying the type of a device in an address structure)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the addressing format of Hinden with The general concept of a device ID in an address area as taught by Marttinen in order to be able to quickly route packets based off of the type of device.

Hinden and Marttinen teach all the limitations of claims 1-3 and 4-5 except for the exact placement of the device ID area within the IPv6 EUI-64 ID (i.e. the device ID is in an area excluding a company ID area and a serial number area of an interface ID area, or exactly within the 4<sup>th</sup> and 5<sup>th</sup> upper bits of the interface ID area).

The exact placement of the device ID area within an address field is the subject of routine experimentation and design choice, and yields no unpredictable results, as both the IPv6 address performs its usual function (i.e. allowing packets to be routed on IPv6 networks) and the device ID area performs its usual function (i.e. allowing a device

type to be identified based off of a field in its address) therefore it would have been obvious to one of ordinary skill in the art to place the device ID area in any part of the IPv6 interface address structure. This reasoning is supported by *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (2007).

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

**Summary Of Applicant's Arguments**

- 1) Applicant argues that the provisional double patenting rejections should be held in abeyance.
- 2) Applicant argues that claim 4 satisfies 36 U.S.C. 101.
- 3) Applicant argues that Hinden does not disclose a serial number area.

**Response to Applicant's Arguments**

1) The examiner maintains the double patenting rejections of record, MPEP 804(I) states: "The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications." As the double patenting rejection is not the only remaining rejection in any of the conflicting applications, the examiner maintains the rejection.

2) The Examiner maintains the rejection of Claims 4-5 under 35 U.S.C. 101 at least because it is directed to a non-functional data structure.

3) Hinden discloses and suggests a serial number area in an interface ID. As taught on page 21, the identifier can be a serial number, making the 'm' bit area a serial number area.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571) 270-1591. The examiner can normally be reached on Monday through Friday 5:30am-2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 9/7/2007

NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER

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